



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Eaton

Commissioner for Patents
Washington, DC 20231

Re: U.S. Utility Patent Application No. 09/938,294
Filed: August 24, 2001
For: Novel Plant Transcribed Regions and Uses Thereof
Inventors: Gregory J. Hinkle *et al.*
Atty. Docket: 38-21(51952)B

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (USPTO) are the following documents:

1. Response to Restriction Requirement ;
2. Certificate of Mailing for Response to Restriction Requirement; and
3. (1) Return receipt-postcard.

It is respectfully requested that the attached postcard be stamped with the date of Filing of these documents, and that it be returned to us. In the event that extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned.

The Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 13-4125, referencing matter number 38-21(51952)B.

Respectfully submitted,



Pamela J. Sisson (Reg. No. 53,600)

Date: 25. April 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re applications of:

Gregory J. Hinkle et al.

Appln. No.: 09/938,294

Filed: August 24, 2001

For: Novel Plant Transcribed Regions
and Uses Thereof

Art Unit: 1638

Examiner: Bui, Phuong T.

Atty. Docket: 38-21(51952)B

Commissioner for Patents
Washington, DC 20231

Certificate of Mailing

I hereby certify that this Response to Restriction Requirement, is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents
Washington, DC 20231

on April 25, 2003

Gracie Williams
(Printed name of person signing this certificate)

Gracie Williams
(Signature)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

GREGORY J. HINKLE *et al.*

Appl. No.: 09/938,294

Filed: 8/24/2001

For: Novel Plant Transcribed Regions and
Uses Thereof

Art Unit: 1638

Examiner: BUI, PHUONG T.

Atty. Docket: 38-21(51952)B/16517.253

Response to Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed March 25, 2003, Applicants submit the following remarks.

Remarks

The application presently contains claims 1-13. In the Office Action mailed March 25, 2003, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: Claims 1-5, drawn to an isolated polynucleotide and transformed host cells and plants, classified in class 536, subclass 23.6;

Group II: Claim 6, drawn to a substantially purified protein, classified in class 530, subclass 372;

Group III: Claim 7, drawn to a purified antibody, classified in class 424, subclass 132.1;

and

Group IV: Claims 11-13, drawn to a transformed plant with transcribed strand complementary to a nucleic acid molecule, classified in class 800, subclass 312.

In the Office Action mailed March 25, 2003, the Examiner also required restriction to one of the following under 35 USC 121. Therefore, election is required of one of inventions I-IV and one of inventions (A)-(AQ).

- (A). SEQ ID No: 1 or a sequence encoding SEQ ID No: 44.
- (B). SEQ ID No: 2 or a sequence encoding SEQ ID No: 45.
- (C). SEQ ID No: 3 or a sequence encoding SEQ ID No: 46.
- (D). SEQ ID No: 4 or a sequence encoding SEQ ID No: 47.
- (E). SEQ ID No: 5 or a sequence encoding SEQ ID No: 48.
- (F). SEQ ID No: 6 or a sequence encoding SEQ ID No: 49.
- (G). SEQ ID No: 7 or a sequence encoding SEQ ID No: 50.
- (H). SEQ ID No: 8 or a sequence encoding SEQ ID No: 51.
- (I). SEQ ID No: 9 or a sequence encoding SEQ ID No: 52.
- (j). SEQ ID No: 10 or a sequence encoding SEQ ID No: 53.
- (K). SEQ ID No: 11 or a sequence encoding SEQ ID No: 54.
- (L). SEQ ID No: 12 or a sequence encoding SEQ ID No: 55.
- (M). SEQ ID No: 13 or a sequence encoding SEQ ID No: 56.
- (N). SEQ ID No: 14 or a sequence encoding SEQ ID No: 57.
- (O). SEQ ID No: 15 or a sequence encoding SEQ ID No: 58.
- (P). SEQ ID No: 16 or a sequence encoding SEQ ID No: 59.
- (Q). SEQ ID No: 17 or a sequence encoding SEQ ID No: 60.
- (R). SEQ ID No: 18 or a sequence encoding SEQ ID No: 61.

- (S). SEQ ID No: 19 or a sequence encoding SEQ ID No: 62.
- (T). SEQ ID No: 20 or a sequence encoding SEQ ID No: 63.
- (U). SEQ ID No: 21 or a sequence encoding SEQ ID No: 64.
- (V). SEQ ID No: 22 or a sequence encoding SEQ ID No: 65.
- (W). SEQ ID No: 23 or a sequence encoding SEQ ID No: 66.
- (X). SEQ ID No: 24 or a sequence encoding SEQ ID No: 67.
- (Y). SEQ ID No: 25 or a sequence encoding SEQ ID No: 68.
- (Z). SEQ ID No: 26 or a sequence encoding SEQ ID No: 69.
- (AA). SEQ ID No: 27 or a sequence encoding SEQ ID No: 70.
- (AB). SEQ ID No: 28 or a sequence encoding SEQ ID No: 71.
- (AC). SEQ ID No: 29 or a sequence encoding SEQ ID No: 72.
- (AD). SEQ ID No: 30 or a sequence encoding SEQ ID No: 73.
- (AE). SEQ ID No: 31 or a sequence encoding SEQ ID No: 74.
- (AF). SEQ ID No: 32 or a sequence encoding SEQ ID No: 75.
- (AG). SEQ ID No: 33 or a sequence encoding SEQ ID No: 76.
- (AH). SEQ ID No: 34 or a sequence encoding SEQ ID No: 77.
- (AI). SEQ ID No: 35 or a sequence encoding SEQ ID No: 78.
- (AJ). SEQ ID No: 36 or a sequence encoding SEQ ID No: 79.
- (AK). SEQ ID No: 37 or a sequence encoding SEQ ID No: 80.
- (AL). SEQ ID No: 38 or a sequence encoding SEQ ID No: 81.
- (AM). SEQ ID No: 39 or a sequence encoding SEQ ID No: 82.
- (AN). SEQ ID No: 40 or a sequence encoding SEQ ID No: 83.
- (AO). SEQ ID No: 41 or a sequence encoding SEQ ID No: 84.
- (AP). SEQ ID No: 42 or a sequence encoding SEQ ID No: 85.
- (AQ). SEQ ID No: 43 or a sequence encoding SEQ ID No: 86.

Applicants respectfully traverse the restriction requirement, and provisionally elect Group I and (B) (claims 1-5 drawn to SEQ ID NO: 2 or a sequence encoding SEQ ID NO: 45) for further prosecution.

Applicants submit that the complete examination of the application would be handled most expeditiously by treating all of the pending claims as a single entity. As Section 803 of the MPEP directs, “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. Rather, a serious burden would arise if the application were restricted.

Applicants submit that the restriction requirement is inappropriate. For example, Applicants contend that, at least, Group I and Group II should be examined simultaneously because they are related as nucleic acids and proteins encoded by nucleic acids comprising SEQ ID NO: 2 or a sequence encoding SEQ ID NO: 45. Accordingly, examination of Group I and II together would pose no undue burden to the Examiner. Furthermore, Applicants submit that restriction to a single nucleotide sequence is improper and Applicants believe no serious burden would result by the search and examination of at least ten nucleotide sequences. Applicants disagree that each nucleotide sequence in the application is necessarily a patentably distinct species, but provisionally elect the species of Group (B) (nucleic acids represented by SEQ ID NO: 2 or a sequence encoding SEQ ID NO: 45) for further prosecution.

Based upon the foregoing, Applicants submit that the restriction requirement is improper and therefore should be withdrawn. To facilitate prosecution, however, Applicants have

provisionally elected, with traverse, Group I and (B) (claims 1-5 drawn to SEQ ID NO: 2 or a sequence encoding SEQ ID NO: 45).

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at (314) 694-6343.

Respectfully submitted,



DATE: 25. April 2003

Pamela J. Sisson
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